

S.N. 09/618,808
Amendment dated April 8, 2004
Reply to Office Action dated January 9, 2004

REMARKS

NEW REJECTION UNDER 35 USC §101

The rejection of claims 47-52 is respectfully traversed. The Office Action asserts that the claims are non-statutory because they recite an invention which is neither "within the technological arts" nor "produces a useful, concrete, and tangible result."

It is submitted that this rejection is in error for two reasons: (1) it overlooks the "useful, concrete, and tangible result" recited in independent claim 47 and fully disclosed in the specification; and (2) it does not conform to what was held by the Federal Circuit to be a useful result under 35 USC §101 in *State Street Bank & Trust Co. v. Signature Financial Group*, 47 USPQ2d 1596 (Fed. Cir. 1998).

The last clause in independent claim 47 here recites "presenting, in order of ranking, at least one of the ranked service providers to the customer for choice to perform the service." It is not seen that this can be dismissed as not constituting a "useful, concrete, and tangible result." It is clearly not purely mathematical nor merely theoretical. The method of claim 47 has practical utility in a commercial setting. It is a method of processing a complex array of marketplace information to coordinate matching customers and providers in a way that balances the interest of both. No basis has been provided in the Office Action for disregarding the practical, commercial utility of the claimed process that is both recited in the claim and described in considerable detail in the specification. It is respectfully submitted that the Office Action overlooked the disclosed and claimed utilitarian aspects of the invention.

In *State Street (supra)*, the Federal Circuit explicitly settled the issue that "transformation of data" constitutes "a useful, concrete and tangible result." Furthermore, the court clarified that once a useful result for a claimed invention is identified, "[t]his renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss." It is

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respectfully submitted that the Office Action is not consistent with the holding in *State Street*.

The Office Action additionally implies that the claimed subject matter does not relate to "technology" unless it recites the use of a computer or other technological device. As noted above, the court in *State Street* made it clear that the determinative issue is utility, not "technology," and that utility includes the manipulation of data to produce a commercially useful output that need not be physical. The *State Street* analysis was not limited to claims that recite a computer, the opinion stating that "for purposes of a §101 analysis, it is of little relevance whether claim 1 is directed to a 'machine' or a 'process,' as long as it falls within at least one of the four enumerated categories of patentable subject matter, 'machine' and 'process' being such categories." By these tests, the present claims are in compliance with the requirements of 35 USC §101. Accordingly, this rejection should be withdrawn.

REJECTIONS UNDER 35 USC §103

The rejections under 35 USC 103 based on the Siegrist *et al.* reference (U.S. Pat. No. 5,652,842) ("Siegrist") are respectfully traversed. Siegrist discloses software for analyzing historic performance data from a plurality of health care providers. The software provides a system for compensating for differences in the types of patients seen and treatments provided, so that a more fair comparison can be made as to the relative quality and cost of health care provided by the various organization. Unlike the claimed invention, Siegrist does not involve a dynamic marketplace that matches the needs of the three parties recited in claim 47 here: customers, paying organizations, and service providers. Siegrist only provides a system for manipulating data in a database of past performance. Thus, Siegrist provides disclosure relating to only the "providing a database" step in the second paragraph of claim 47 here. However, that paragraph of claim 47 differs from

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Siegrist in that Siegrist discloses nothing regarding "supplemental inducements." The attempt in the Office Action to equate "supplemental inducements" as used in the present invention with specialized services of certain health care organizations is inappropriate. These specialized services in Siegrist are essentially permanent characteristics of the particular organization, unlike the temporary offers used to attract additional customers as used in the present invention. Furthermore, since Siegrist is not actively involving "customers," such supplemental inducements" would have no relevance to the Siegrist environment.

An additional significant difference can be noted in the step recited in the third paragraph of claim 47 here ("obtaining service need information" from a "customer"). Such a step does not exist in Siegrist. Therefore, there is nothing in Siegrist corresponding to any of the subsequent steps in claim 47 since all of those steps operate upon the individually gathered "service need information" of a particular customer. The Office Action speculates at length, with no basis in the prior art itself, as to how the Siegrist database could be used by customers to select their health care provider. Even if that were the case, Siegrist provides no disclosure of a market management system for linking the customer's needs with the providers' features. Even more pertinently, Siegrist does not suggest a market system that dynamically adjusts the matching of customer with provider based upon the multiple factors recited in claim 47 here, including "supplemental inducements." It is respectfully submitted that the Office Action has liberally engaged in hindsight reconstruction of applicants' claimed invention.

The rejection under 35 USC §103 based on Siegrist in view of the Borghesi *et al.* reference (U.S. Pat. No. 5,950,169) ("Borghesi") is respectfully traversed. The deficiencies in Siegrist have been noted above. It is not seen what in the prior art would motivate one to consult Borghesi in conjunction with the teachings of Siegrist. Siegrist is concerned with evaluating health care providers, and Borghesi deals with software for auto repair shop estimating and payment. The Office Action provides no basis for combining these disparate references.

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Even if such a combination were to be made, Borghesi would not remedy the deficiencies of Siegrist since Borghesi likewise does not deal with a market coordination process as recited in the claims here. Rather, Borghesi involves electronically expediting the estimating, repair approval, and payment processes among a repair shop, an insurance company, and a policyholder. The Office Action argues that the improbability of combining these references and, if combined, the shortcomings in their combined teachings is justified by the alleged broad vagueness of the claim recitations here. It is respectfully submitted that a combination of references needs to be properly based, regardless of the perceived breadth of the claims. Without motivation provided by the prior art itself, an obviousness combination is not proper. Review of the rejection based on this combination of references in view of the well-established standards is respectfully requested. Other shortcomings of the Borghesi references have been pointed out in the previous response and are maintained.

The Office Action dismisses the absence from the teachings of the references of a feature corresponding to the recitation of "supplemental inducements" in the present claims by asserting that "applicant merely makes a vague mention of supplemental inducements." It is respectfully submitted that it is not proper to disregard a claim recitation that otherwise satisfies §112. In this case the meaning of the expression "supplemental" is well established in the specification. It used repeatedly throughout the specification in association with various discounts, price reductions, and free offers. The word "inducement" has an ordinary dictionary definition which, particularly in a customer/service provider marketplace, has a clear meaning. It is submitted that "supplemental inducement" in the context of the claim recitations and in the light of the specification has a clear meaning to one of ordinary skill in the art. It is improper to disregard this claimed feature. When given proper weight, this term provides a basis for distinguishing the invention recited in claim 47 from the references.


The Office Action inexplicably asserts that the claimed invention "does not match needs per se." This appears to overlook the explicit recitation to the contrary

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in the fourth paragraph of claim 47. Both Siegrist and Borghesi lack teachings of gathering and processing data based on needs of a particular customer. The references, whether taken singly or in combination, fail to suggest a market coordinating system as claimed here.

In summary, the rejections of claims 47 – 52 based Siegrist alone or in combination of Borghesi are believed to be in error and should be reconsidered and withdrawn.

Respectfully submitted,



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